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09/758,263	01/12/2001	Gholam A. Peyman	41186	9206

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EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 06/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/758,263

Applicant(s)

Payman

Examiner

d. shay

Group Art Unit

3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on August 8, 2002.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-25 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-25 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The obviousness rejection set forth in the previous office action is hereby repeated.

Claims 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklar et al in combination with Davenport et al. Sklar et al teach a laser device as claimed. Davenport et al teach an ocular implant as claimed. It would have been obvious to the artisan of ordinary skill to possess those devices, since the corneal implant could be used on patients which require an optical correction so great that it cannot be provided by laser surgery and the laser system used on the other patients thus producing a system such as claimed.

Applicant argues that the laser of Sklar is not “adapted to separate...” emphasizing the “offset” nature of the surfaces. The examiner respectfully notes that the “adapted to” language of applicant falls under the category of language that suggests or makes optional, but does not require the steps to be performed or does not limit the scope of a claim or claim limitation (see MPEP 2106). As applicant has provided no definition of the term “adapted to” there is no definition to supplant this normally understood meaning of the phrase. The examiner further notes that there is no structure defined in Sklar et al which would prevent the laser from being used in the manner suggested by applicant’s claim language, nor is there any particular construction of the instant ultra-short pulse laser set forth in the instant disclosure that is not disclosed in Sklar et al other than the intended use, only the pulse width of the instant laser is disclosed. Similarly, there is nothing in the “adapted to” language discussing the intended use of the implant preventing the implant of Davenport et al to be used in a similar manner. Thus the

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excimer laser portion of the laser system of Sklar reads on the claimed second laser; and the ultra-short laser pulse producing section of the system of Sklar reads on the claimed first laser.

Applicants submission of the Terminal Disclaimer is noted. The Disclaimer has not yet been processed, although it has been received. Once processed and determined to be proper, the Terminal Disclaimer will obviate the following double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16 and 23-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6, 217, 571 in view of Bille et al. Bille et al teach the use of an ultrashort pulse later to create a stromal pocket. It would have been obvious to the artisan of ordinary skill to create the stromal pocket with the laser of Bille et al, since this leaves a smoother surface (see column 10, lines 20-29) as taught by Bille et al, thus producing a method such as claimed.


Applicant's arguments filed August 8, 2002 have been fully considered but they are not persuasive. The arguments are not convincing for the reasons set forth above.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to David Shay at telephone number 308-2215.



DAVID M. SHAY.  
PRIMARY EXAMINER  
GROUP 330

Shay/DI

June 3, 2003